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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Alltrade Inc. v. Star Pipe Products, Inc.

Opposition No. 111,616 to Application Ser. No. 75/239,861
filed February 12, 1997

Robert R. Thornton for Alltrade Inc.

G. Michael Roebuck of Madan, Mossman & Sriram for Star Pipe Products, Inc.

Before Seeherman, Hanak and Hairston, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Star Pipe Products, Inc. (applicant) seeks to register ALLGRIP in typed drawing form for "coupling and restraint devices for pipes and joints, namely, metal pipe fittings, metal pipe connectors, metal pipe collars, metal pipe couplings and joints." The intent-to-use application was filed on February 12, 1997.

Alltrade, Inc. (opposer) filed a notice of opposition alleging that prior to February 1997, it had used the identical mark ALLGRIP for pliers. Furthermore, opposer alleged that on June 30, 1998 it obtained a federal

registration of the mark ALLGRIP in typed drawing form for "hand tools, namely, pliers." Registration No. 2,170,255. Continuing, opposer alleged that the contemporaneous use of the identical mark by the parties for their respective goods is likely to cause confusion, mistake and/or deception. While opposer did not make specific reference to Section 2(d) of the Trademark Act, it is clear that this is one basis for the Notice of Opposition. Finally, opposer alleged that "applicant's use and registration of the alleged mark submitted for registration will tend to dilute the distinctiveness of opposer's mark." (Notice of opposition paragraph 10). However, as opposer makes clear at page 15 of its reply brief, opposer has not pursued its dilution claim. Accordingly, we will not consider this claim.

Applicant filed an answer which denied the pertinent allegations of the notice of opposition. Subsequently, applicant filed a most confusing set of papers. First, applicant filed a motion to amend its answer stating that applicant "erroneously admitted allegation No. 2 of the Notice of Opposition that the application [of applicant] was an intent-to-use application filed on February 12, 1997

when, in fact, it was a use-based application under Section 1(a) of the Trademark Act ... [with a] date of first use of March 13, 1996." Applicant's proposed amended answer added paragraph 17 in which applicant sought to cancel opposer's registration on the grounds that "applicant's first use of [its] mark predates both the filing date of opposer's mark and the applicant's [?] date of first use." Thereafter, applicant filed a motion to withdraw its first motion to amend its answer and a second motion to amend its answer. In its second amended answer, paragraph 17 was modified to include the following sentence: "Applicant seeks such cancellation on the grounds that applicant's first use of [its mark] on March 19, 1997 ... predates the date of first use of opposer's mark of January 1, 1998." In its second motion to amend, applicant stated that its "first motion erroneously claimed that [its] trademark application for the mark ALLGRIP ... was a use-based application." Applicant then acknowledged that its application was indeed an intent-to-use application. Finally, applicant filed a motion to withdraw both its first and second motions to amend its answer stating that "the net effect of such a withdrawal would be to leave the applicant's original response [answer]

to the Notice of Opposition unchanged." The Board granted applicant's most recent request in an order dated November 30, 1999.

Thus, there is before the Board no counterclaim seeking to cancel opposer's registration. Moreover, in its brief, applicant never argued that opposer's registration should be cancelled.

Both parties have filed briefs. Neither party requested a hearing. The description of the record and the statement of issues are set forth at pages 1 and 2 of opposer's brief. At page 6 of its brief, applicant states that it accepts both opposer's description of the record and statement of the issues. The only comment this Board has with regard to the "record" is to note that opposer is quite correct in its objection to those exhibits which applicant attached to its brief which were not introduced during the trial. The Board has given no consideration to these exhibits.

At the outset, we note that opposer has properly made of record a certified status and title copy of its Registration No. 2,170,255 for the mark ALLGRIP depicted in typed drawing form for "hand tools, namely, pliers." Thus,

despite the aforementioned convoluted set of proposed amended answers and counterclaims filed by applicant (subsequently withdrawn), priority of use rests with opposer. King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Hence, the only issue in this proceeding is one of likelihood of confusion.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.")

Considering first the marks, they are identical. Thus, the first Dupont "factor weighs heavily against applicant" because the two word marks are identical. In re Martin's Famous Pastry Shoppe Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984). Moreover, it must be remembered that applicant seeks to register ALLGRIP in typed drawing form. This means that in our likelihood of confusion analysis, we must consider all reasonable manners in which applicant

could depict its mark ALLGRIP. Phillips Petroleum v. C. J. Webb, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). Because applicant's mark consists of two distinct words (ALL and GRIP), one reasonable manner of depiction would be to depict the ALL portion of applicant's mark in one color or type face and the GRIP portion of applicant's mark in a second color or type face. In this regard, we note that opposer, in its packaging and advertising, consistently depicts its mark ALLGRIP with the ALL portion in one color and type face and the GRIP portion in a second color and type face. See opposer's exhibits 7, 10, 11, 12, 13, 14, 15 and 16. Thus, in terms of visual appearance, it is somewhat of an understatement to merely indicate that the marks of the parties are identical. Because applicant is seeking a typed drawing registration of ALLGRIP, it would be free to depict ALLGRIP just as opposer does, namely, with the ALL portion in one color and type face and the GRIP portion in a second color and type face.

Turning to a consideration of applicant's goods and opposer's goods, we note that because the marks are identical, their contemporaneous use can lead to the assumption that there is a common source "even when [the]

goods or services are not competitive or intrinsically related." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).

However, in this case we find that applicant's goods and opposer's goods are definitely related. As described in its registration, opposer's goods are pliers. This includes pliers of all types. As described in its application, applicant's goods include metal pipe fittings, metal pipe connectors and metal pipe couplings. As applicant's exhibits make clear, metal pipe fittings, connectors and couplings include bolts and nuts. See applicant's exhibits 1, 2, 5 and 9. Obviously, pliers can be used to tighten or loosen bolts and nuts. Indeed, applicant's own witness (Daniel W. McCutcheon) conceded at page 28 of his deposition that various types of pliers can be used "to fasten and unfasten nuts and bolts." While Mr. McCutcheon stated that individuals should use torque wrenches to install applicant's ALLGRIP products, Mr. McCutcheon also acknowledged that other tools such as socket wrenches and pliers could be used in the installation of applicant's ALLGRIP products. (McCutcheon deposition pages 24 and 28).

In any event, even if we were to make the totally

unsupported assumption that pliers were never used in conjunction with applicant's actual ALLGRIP metal pipe fittings, connectors and couplings, it must be remembered that the focus in this opposition proceeding is not upon opposer's actual goods and applicant's actual goods, but rather upon the goods as described in opposer's registration and applicant's application. As our primary reviewing Court has made abundantly clear, "in a proceeding such as this, the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-a-vis the goods and/or services recited in opposer's registration, rather than what the evidence shows the goods and/or services to be." Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

Applicant's chosen description of goods is broad enough to include metal pipe fittings, connectors and couplings of all types, and not just applicant's actual specialized metal pipe fittings, connectors and couplings for use in water treatment plants, sewage treatment plants and water lines. (McCutcheon deposition page 11). Thus, applicant's own chosen description of goods is broad enough to include metal

pipe fittings, connectors and couplings that are installed in residential dwellings by ordinary plumbers and home owners.

In this regard, the packaging for opposer's ALLGRIP adjusting pliers emphasizes that opposer's pliers are particularly suited to be used in connection with ordinary residential plumbing projects. (Opposer's exhibit 7). Indeed, the very first "around the house" job listed on opposer's ALLGRIP packaging is plumbing. Moreover, the only job pictured on opposer's packaging is a plumbing job featuring opposer's ALLGRIP pliers holding, in one instance, a residential pipe and, in a second instance, a washer. Not only are residential plumbing projects featured prominently on opposer's ALLGRIP packaging, but they are also featured prominently in opposer's television and point-of-sale advertising for its ALLGRIP pliers. Opposer's ALLGRIP television commercial (opposer's exhibit 16) commences with the following voice-over: "It's time to sink that tool Titanic." (emphasis added). The video accompanying this voice-over shows an open toolbox filled with an assortment of pliers, wrenches, and the like being discarded. Thereafter, this television commercial features ordinary

homeowners using opposer's ALLGRIP pliers on a variety of residential plumbing jobs. A typical statement in the commercial is as follows: "Use ALLGRIP to take care of all your plumbing needs." Likewise, opposer's point-of-sale video demonstrating how its ALLGRIP pliers are used emphasizes plumbing projects with such statements as it "grips pipes and fittings." (Opposer's exhibit 15).

Thus, even if we assume for the sake of argument that applicant's actual goods are expensive and that applicant's actual goods are purchased only by sophisticated individuals, nevertheless, applicant's chosen description of goods is broad enough to include goods which are relatively inexpensive and which are purchased by unsophisticated home owners. These are the very same ordinary, unsophisticated individuals that opposer markets its ALLGRIP pliers to for a variety of residential plumbing projects.

As for applicant's argument that there has been no actual confusion, three comments are in order. First, proof of actual confusion is not required for a finding of likelihood of confusion. Second, both opposer's and applicant's products have been in the market for just a few years. Thus, the chance for actual confusion to have

occurred has been minimal. Finally, as a corollary to the foregoing, it may be that the opposer's and applicant's actual goods are rarely used together.

Finally, we simply note that to the extent that there is any doubt on the issue of likelihood of confusion, said doubt is resolved in opposer's favor in view of opposer's unchallenged federal registration of its mark ALLGRIP for pliers. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Decision: The opposition is sustained.